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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,128	12/07/2000	Michael E. Gilleland	NORT-0081 (12964DMUS01U)	9613
21906	7590	05/10/2006	EXAMINER	LIM, KRISNA
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/732,128	GILLELAND, MICHAEL E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Krisna Lim	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 February 2006.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

Applicant's arguments that Holden is disqualified as prior art under 35 U.S.C. § 103 c) and the request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, 33-38 and 41, drawn to a method comprising the steps of: a) receiving a call request ...; b) looking up information about the calling part ...; and c) receiving and providing the information about the calling party, classified in class 370, subclass 201.07.
- II. Claims 19-32, drawn to an apparatus comprising: a) an interface to receive an invitation comprises a Session Initiation Protocol message ...; and b) a controller communicatively coupled to the interface for providing information regarding purchases of the calling party ..., classified in class 370, subclass 88.18.
- III. Claims 39-40, drawn to a method of establishing a call session in a data network comprising the steps of: a) intercepting a Session Initiation Protocol message ...; b) storing information regarding purchase ...; and c)

transmitting the Session Initiation Protocol message, classified in class 370, subclass 70.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed of Invention I, claims 1-18, 33-38 and 41, does not require an apparatus comprising: a) an interface to receive an invitation comprises a Session Initiation Protocol message ...; and b) a controller communicatively coupled to the interface for providing information regarding purchases of the calling party ... and the subcombination Group II, claims 19-32, does not require: a method comprising the steps of: a) receiving a call request ...; b) looking up information about the calling part ...; and c) receiving and providing the information about the calling party.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed of Invention I, claims 1-18, 33-38 and 41, does not require a method of establishing a call session in a data network comprising the steps of: a) intercepting a Session Initiation Protocol message ...; b) storing information regarding purchase ...; and c) transmitting the Session Initiation Protocol message. And the subcombination Group III, claims 39-40, does not require: the steps of: a) receiving a call request ...; b) looking up information about the calling part ...; and c) receiving and providing the information about the calling party.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed of Invention II, claims 19-32, does not require a method of establishing a call session in a data network comprising the steps of: a) intercepting a Session Initiation Protocol message ...; b) storing information regarding purchase ...; and c) transmitting the Session Initiation Protocol message. And the subcombination Group III, claims 39-40, does not require: an apparatus comprising: a) an interface to receive an invitation comprises a Session Initiation Protocol message ...; and b) a controller communicatively coupled to the interface for providing information regarding purchases of the calling party.

5 For example, the searches for these two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

- 1) The Group I search (claims 1-18, 33-38 and 41) would require use of search class 370, subclass 201.07 (which would not required for the groups II and III).
- 2) The Group II search (claims 19-32) would require use of search class 370, subclass 88.18 (which would not required for the groups I and III).
- 3) The Group III search (claims 39-40) would require use of search class 370, subclass 70 (which would not required for the groups I and II).

A shortened statutory period for response to this action is set to expire 30 days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

May 5, 2006



KRISNA LIM  
PRIMARY EXAMINER